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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,715	06/28/2006	Hye-Jin Lee	2093-06	8575

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EXAMINER	
MEHTA, HONG T	

ART UNIT	PAPER NUMBER
1784	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/581,715	LEE, HYE-JIN	
	Examiner	Art Unit	
	HONG MEHTA	1784	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to applicant's amendments filed on June 18, 2010.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2010 has been entered.

Claims 1-20 are cancelled. New claims 21-23 are under examination.

Claim Objections

2. Claims 22 and 23 as submitted do not reflect the appropriate status of the claims. Claims 20 and 23 were submitted as "Original" but the status of these claims should have been submitted as "New". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 22 and 23 are indefinite because the claims are dependent upon cancelled claim 20. The claims are interpreted as dependent upon claim 21. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren (US 4,161,548) in view of Chikako (JP 61-141864), Hansen (US Pat No. 2316861) and CFR Title 21 Part 110 (FDA, Good Manufacturing Practice in Manufacturing, Packing, or Holding Human Food)**.

5. Warren discloses a method of preparing hard cooked eggs with flavoring (col. 1, lines 57-67; col. 2, lines 28-35). Warren discloses a process wherein partly cooked egg with a thin layer of cooked egg white (solidified albumin) surrounds raw yolk (col. 2, lines 7-13; col. 4, claim 1). Warren teaches that the egg is fixedly erected or that the injection hole is formed on the end of the long axis ('548, Figure 1, 3 and 4). Warren teaches holding an egg in a erect position and inserting an needle into the end of the long axis of an egg ('548, figure 1 shows the orientation of the egg and the mixing needle or element 12 above it, the injector is in the form of a needle or syringe with an outer guide to pierce the shell of the egg). Warren teaches that spices ('548, col. 1, lines 56-64) and concentrated flavorings ('548, col. 2, lines 36-41) are injected in the pathway of the needle ('548, col. 4, lines 12-21). Flavorings are considered edible spices. Additionally, it would have been obvious to one of ordinary skill to inject any known flavoring (edible material) whether natural or man made for the purpose of adding desired flavoring to the egg product.

6. Warren is silent on removing at least part of the content of raw egg. However, Chikako discloses to withdraw contents including albumin and/or yolk followed by addition of edible material to the shell of the egg through a hole in the shell ('864, Abstract). Given the teachings of Chikako as outlined above, it would have been

obvious to a person of ordinary skill in the art at the time of invention to have used the injector of Warren to execute the invention of Chikako. The motivation to do so would have been to prepare a boiled egg containing a food material different from the egg components using known techniques and apparatus to perform the steps ('864, Abs.).

7. With respect to the amount of injected edible composition, the references used herein do not teach how much of an edible composition may or may not be added to the egg shell. However, the methods taught by Warren and Chikako would allow the person of ordinary skill in the art to add as much or as little material as desired. It therefore would have been obvious to one of ordinary skill in the art at the time of invention to have added within 10% of the volume of the egg to the egg shell to form an egg that has desirable characteristics such as consistency and flavor. Additionally, with respect to the amount within 10% of edible materials, such as vitamins, edible pigments, and edible spices to the volume of egg, attention is invited to In re Levin, 84 USPQ 232, and the cases cited therein, which are considered pertinent to the fact situation of the instant case, and wherein the Court sates on page 234 as follows: This court has taken the position that new recipes or formulas for cooking food which involve the addition of elimination of common ingredients or for treating them in a ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new,

unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ221.

8. Warren teaches mixing the injected contents and the interior contents of an egg by shaking but does not say how that it is accomplished ('548, col. 4, lines 12-21). Agitators for mixing the interior contents of an egg are known in the art. Hansen teaches an egg beater which mixes the interior portion of an egg by inserting an agitator through a hole at the end of the long axis of an egg at which time springs (17) extend from the blade (16) ('861, Figs.1 and 2; col. 2, lines 15-26). It would have been obvious to a person of ordinary skill in the art at the time of invention to have performed the mixing taught by Warren with the agitation taught by Hansen as Hansen clearly teaches an effective agitation technique that allows the contents of the egg within the shell to remain contained therein ('861, col. 1, lines 4-5).

9. Warren does not suggest a cleaning and sterilizing step before forming an injection hole. However, it is well known in the art of manufacturing that Good Manufacturing Practice Regulations under the authority of Federal Food, Drug and Cosmetic Act (p. 214-215) to ensure sanitation and cleanliness to minimize or eliminate contamination in raw material food ingredients, such as eggs. It would have been obvious to one of ordinary skill in the art to ensure the raw material or egg is cleaned and sterilized before further processing the raw materials, since it is a known and regulated practice in the food industry.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HONG MEHTA whose telephone number is (571)270-7093. The examiner can normally be reached on Monday thru Thursday, from 7:30 am to 4:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Htm

/Jennifer C. McNeil/
Supervisory Patent Examiner, Art Unit 1784